

Serial No.: 10/676,705
Filing Date: September 30, 2003

REMARKS

Claims 1-37 are pending, claims 29-34 and 36-37 are withdrawn. Amendment to and cancellation of the claims does not affect inventorship.

Restriction Requirement

I. Groups I – IV

The Examiner requires restriction between Groups I-IV, directed variously to polypeptides, nucleic acids, and methods.

Applicants respectfully elect Group I, claims 1-29 and 35, drawn to variant type I interferon proteins, and a pharmaceutical composition thereof, classified in class 424, subclass 85.4, **without traverse**.

Applicants will amend the method claims during prosecution to remain consistent with the elected polypeptides, and will request rejoinder upon allowance.

II. Restriction between Interferon Molecules

The Examiner requires further restriction between wild-type interferon molecules defined by SEQ ID NOS:1-18.

Applicants elect SEQ ID NO:15 (human interferon beta) **without traverse**.

III. Restriction between specific modifications/substitutions

The Examiner requires election of a specific modification and substitution from among the elected interferon molecules. Applicants respectfully **traverse** this ground for restriction.

The present restriction requirement should be at most an election of species requirement regardless of whether the groups are "separate and patentably distinct." When a Markush group (*i.e.* the Markush group listing specific positions and amino acid substitutions) is restricted, the M.P.E.P. states:

[a] Markush-type claim may include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability.... If the Markush-type claim is not allowable over the prior art, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

M.P.E.P. § 803.02.

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As discussed in M.P.E.P. § 803.02, the examiner may require a provisional election of a single species in the Markush group prior to examination on the merits. If the Markush-type claim is not allowable over the art, the provisional election will be given effect and examination will be limited to the Markush-type claim. If the claims are free of the art, the other species will then be examined.

In the present case, the positions and amino acid substitutions are part of a Markush group directed to a series of positions and substitutions. As articulated in the M.P.E.P., the Examiner may require a provisional election of species to a specific modification or substitution, not a restriction requirement. Once it is determined that the elected species is free of the prior art, the Examiner may proceed to the examination of additional species.

Restriction of a Markush-type claim to specific modifications and substitutions, particularly when such modifications and substitutions are to a specific amino acid sequence defined by a specific SEQ ID NO, is improper. Applicants respectfully request that this ground for restriction be withdrawn. If the Examiner upholds the restriction requirement, Applicants elect position 8 and the substitution F8E **with traverse**. Claims 10-12, 20-21, and 27-28 recite the elected species.


If the Examiner withdraws this ground for restriction and requires an election of species consistent with the restriction requirement, Applicants elect the species F8E.

Conclusion

Applicants believe the present application is in condition for allowance. Early favorable communication thereof is respectfully requested. Please direct any calls in connection with this application to the undersigned at (415) 781-1989.

Respectfully submitted,
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